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10/635,624

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Adam Sommer

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EXAMINER

RANKINS, WILLIAM E

ART UNIT

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3696

MAIL DATE

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12/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/635,624	Applicant(s) SOMMER, ADAM	
	Examiner WILLIAM E. RANKINS	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-36,73-89 and 123-165 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-36,73-89 and 123-165 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 03/22/2004 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Status of Claims

Claims 25-36, 73-89 and 123-165 are pending in this application. Claims 25, 30 and 35 are amended. Claims 123-165 are new.

Response to Arguments

1. Applicant's arguments with respect to claims 25-36 and 73-89 have been considered but are moot in view of the new ground(s) of rejection.
2. Claims 25, 73, 130, 131 and 162 are noted by the examiner as invoking 35 USC § 112, 6th Para.

EXAMINER'S AMENDMENT

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1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ryan Barker on 12/12/2008.

The application has been amended as follows:

Claims 123, 124 and 130 are dependent upon claim 25.

A review of the claims and updated search necessitated the rejections below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 25-29, 73-76, 78, 83, 123, 138-161, 163 and 165 are rejected under 35 U.S.C. 102(b) as being anticipated by Himmelstein (2002/0032643).

As per claim 1;

Himmelstein discloses:

An exchange system comprising:

means for allowing a first user to offer a first amount of a first article of commerce in trade for a second amount of a second article of commerce (Abstract, Para. 0041), wherein the first user has the first amount of the first article of commerce in an escrow account, the first amount of the first article of commerce being placed on hold within the account of the first user for as long as the offer is active (Para's. 0104, 0109 and 0110); and

means for allowing a second user to accept the offer of the first user (Para. 0109).

As per claim 26;

Himmelstein discloses:

The system of claim 25, wherein the allowing to offer means includes a database to store the offer of the first user (Abstract).

As per claim 27;

Himmelstein discloses:

The system of claim 25, wherein the allowing to offer means includes computer software (Para. 0039).

As per claim 28;

Himmelstein discloses:

The system of claim 25, wherein the allowing to accept means includes computer software (Para. 0109).

As per claim 29;

Himmelstein discloses:

The system of claim 25, further comprising means for allowing ownership of the first amount of the first article of commerce to be transferred to the second user and for ownership of the second amount of the second article of commerce to be transferred to the first user (Para's. 0112 and 0114).

Claim 73 and 78 are similarly rejected by the recitation provided for claim 25.

Claim 74 is similarly rejected by the recitation provided for claim 26.

Claim 75 is similarly rejected by the recitation provided for claim 27.

Claim 76 is similarly rejected by the recitation provided for claim 28.

Claim 83 is similarly rejected by the recitation provided for claims 25-28.

As per claim 123;

Himmelstein discloses:

The system of claim 1, further including means for transferring the first amount of the first article of commerce that is on hold to the second user upon acceptance of the offer by the second user (Para. 0112).

As per claim 138;

Himmelstein discloses:

The system of claim 73, wherein the first non-currency article is a first stock share (Para's. 0002 and 0112).

Claims 139-161 are rejected under the same rationale used to reject claim 138.

Claims 163 and 165 are rejected under the same rationale used to reject claim 25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 30-36, 77, 79-82, 84-89, 124-129, 132, 133, 135 and 137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmelstein (2002/0032643) in view of Florance et al. (2002/0065739).

As per claim 30;

Himmelstein discloses:

An exchange system comprising an offer-storing database, the database being configured to store offers to trade amounts of articles of commerce for amounts of other articles of commerce, the articles of commerce being held in escrow accounts and the offers being selectable by a second user (As per claim 25).

Himmelstein does not disclose:

The database further storing an indication of a subscription status of second user.

However, Florance discloses:

A digital marketplace to facilitate commercial real estate transactions (abstract) which is modeled after securities industry systems (Para. 0112), Including a database and providing each user with a subscription status (Para. 0078).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Himmelstein and Florance.

One of ordinary skill in the art would have been motivated to do so per KSR rationale C. Where Himmelstein provides the base device and Florance provides the improvement which is comparable to the claimed invention. Due to Florance's reliance on prior art in the securities industry it would have been obvious for one of ordinary skill in the art to use the subscription method and system of Florance to improve trading systems.

As per claim 31;

Himmelstein discloses:

The exchange system of claim 30, wherein offers selected by the second user can then be accepted by the second user (Para. 0106).

As per claim 32;

Himmelstein discloses:

The exchange system of claim 31, wherein the accepted offers are removed from the offer-storing database (Para. 0159).

Claim 33 is rejected under the same rationale used to reject claim 30.

Claim 34 is rejected under the same rationale used to reject claim 25.

As per claim 35;

Himmelstein discloses:

A method in a computer system for exchanging articles of commerce, the method comprising the steps of:

receiving, over a communication network from [[a]] the first client, a transmission of an offer to exchange a first amount of a first article of commerce for a second amount of a second article of commerce, the first client having the first amount of the first article of commerce in a first escrow account; storing the offer; permitting the offer to be

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communicated to a second client; and receiving, over the communication network from the second client, a transmission of an acceptance of the offer, the second client having the second amount of the second article of commerce in a second escrow account (As per claims 25 and 30).

Himmelstein does not disclose:

Verifying that a first client is subscribed to an exchange system.

However, Florance discloses:

Associating each user with a subscription status (Para. 0378).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Himmelstein and Florance. One of ordinary skill in the art at the time of this invention would have been motivated to do so according to the rationale provided in claim 30.

As per claim 36;

Himmelstein discloses:

The method of claim 35, wherein, upon completion of the receiving an acceptance step, the system transfers articles from the first account to the second account and from the second account to the first account (Para. 0112).

Claim 77 is similarly rejected by the recitation provided for claim 36.

Claim 79 is similarly rejected by the recitation provided for claim 31.

Claim 80 is similarly rejected by the recitation provided for claim 32.

Claim 81 is similarly rejected by the recitation provided for claim 33.

As per claim 82;

Himmelstein discloses:

The exchange system of claim 78, wherein the offers stored in the database are created by a first user (Para. 0027).

Claim 84 is similarly rejected by the recitation provided for claim 82.

Claim 85 is similarly rejected by the recitation provided for claim 36.

Claim 86 is similarly rejected by the recitation provided for claims 25-30, abstract and Para. 0030.

As per claim 87;

Himmelstein discloses;

The method of claim 86, further comprising the step of providing for notifying the first user and the second user of the exchange (Para. 0004).

As per claim 88;

Himmelstein discloses:

The method of claim 86, further comprising the step of providing for verifying that the first amount of the first non-currency article of commerce is available to be traded (Para. 0104).

Claim 89 is similarly rejected by the recitation provided for claim 88.

As per claim 124;

Himmelstein does not disclose:

The system of claim 1, further including software that requires a user to obtain a subscription to the system.

However, Florance discloses:

A system which requires a subscription for brokers and buyers (Para. 0044).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Himmelstein and Florance. One of ordinary skill in the art at the time of this invention would have been motivated to do so according to the rationale given for claim 30.

As per claim 125;

Himmelstein does not disclose:

The system of claim 124, wherein the software allows the subscribed user to exchange articles of commerce within the system, the exchanges being free from per-transaction charges.

However, Florance discloses:

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A monthly subscription allowing unlimited use within the subscription parameters where use beyond the prescribed amount results in a peruse fee (Para. 0078 and 0079).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Himmelstein and Florance. One of ordinary skill in the art at the time of this invention would have been motivated to do so according to the rationale provided in claim 30.

Claims 126-128 are rejected under the same rationale used to reject claim 125.

Claim 129 is rejected under the same rationale used to reject claims 30 and 125.

As per claim 132:

Himmelstein discloses:

The system of claim 30, wherein the database notes what articles are part of offers on the system and provides an indication within the account holding the first amount of the first article of commerce that the first amount of the first article of commerce is on hold, the amount being on hold for as long as the offer is active (Para. 0104).

As per claim 133;

Himmelstein discloses:

The system of claim 132, wherein the database records a transfer of the first amount of the first article of commerce that is on hold to the second user upon acceptance of the offer by the second user (Para. 0112).

Claim 135 is rejected under the same rationale used to reject claim 129

Claim 137 is rejected under the same rationale used to reject claim 127.

2. Claims 130, 131, 134, 136, 162 and 164 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmelstein (2002/0032643) in view of Florance et al. (2002/0065739) and Official Notice.

As per claim 130:

Himmelstein does not disclose:

The system of claim 25, further including means for confirming that the first user is validly subscribed to the system.

However, the examiner takes Official Notice that subscription status and fee paid validation or confirmation is old and well known.

Claim 131 is rejected under the same rationale used to reject claim 130.

Claims 134, 136, 162 and 164 are rejected under the same rationale used to reject claims 130 and 131.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/

Examiner, Art Unit 3696

12/15/2008

/Daniel S Felten/

Primary Examiner, Art Unit 3696